

REMARKS

Claims 8-23 are in the application. All of the claims are finally rejected on the same basis presented in art rejections set forth in the Office Action mailed 27 June 2008. Claims 8, 10-11, 13, 15 and 20-23 stand rejected under Section 103 based on Chiles (U.S. 2001/0034759) in view of the SGI paper. Claims 9, 12, 14 and 16-19 are rejected under Section 103 based on the foregoing in further view of the Microsoft TechNet publication (TechNet).

The amendment filed 17 September 2008 identified deficiencies in the rejection of independent claims 8 and 23. In response to those arguments, the outstanding Office Communication presents argument which includes some support for the rejection, but (i) it does not address all of the deficiencies identified by the Applicants' prior response, and (ii) presents argument which is not supported by the prior art used to reject the claims. Accordingly, the Examiner is requested to withdraw the rejections or to issue a complete statement addressing each of the points previously raised by the applicants as well as the points raised herein.

With regard to deficiencies already made of record, Applicants again urge that, despite the Examiner's citation of numerous passages and figures in the combination, it is still not seen that the combination of claim 8 can be obvious in view of Chiles and the SGI paper. Applicants disagree with the Examiner's interpretation of the SGI paper, and the Examiner's argument lacks necessary support to constitute a prima facie case of obviousness. It is necessary to identify every feature present in the claims in order to support a rejection. The record does not comply with this requirement and the applicants have attempted, without success, to find the requisite support. There is no support for constructing the combination as claimed.

In this regard, the Examiner's position appears to be that each of the references (Chiles or the SGI paper) provides one of the following elements a or b:

- a. assigning to the network node device a globally unique address so that the network node device forms a network-end terminal point of the tunnel connection when a plurality of network elements jointly use the tunnel connection;
- b. assigning to a network element a globally unique address so that the network element forms a network-end terminal point of the tunnel connection when the network element requires a global address for executing an application, and when the tunnel connection is exclusively used by the network element

while claim 8 is directed to a method which requires both elements. While under certain circumstances it might be permissible to substitute one element for the other element to reconstruct the prior art, the invention of claim 8 requires both elements and there is no basis to suggest that one skilled in the art would form the claimed combination by reading these two references. Applicants again request the Examiner's assistance in understanding how the Examiner can use these references to create a prima facie case of obviousness. Applicants cannot find support for the rejection.

By way of example, despite argument presented at pages 10-12 of the Final Office Communication, it is still not seen how the SGI reference can be applied to reject the claims. Specifically, Figure 3.2 and related text in the SGI reference do not at all concern a

“tunnel connection ... exclusively used by the network element ... [see claim 8]”

How can the Examiner conclude (at page 11) that the SGI reference can disclose such, merely because the reference provides for tunnels between work stations in different networks? This is not what is claimed. There is not even a basis to conclude that the cited disclosure of the SGI paper differs from the first element of “assigning to the network node device a globally unique address so that the network node device forms a network-end terminal point of the tunnel connection when a plurality of network elements jointly use the tunnel connection ...” That is , it appears that the disclosure in the SGI paper is so thin that one cannot determine whether it should be read on the first element or on second element of “assigning to a network element a globally unique address so that the network element forms a network-end terminal point of the tunnel connection when the network element requires a global address for executing an application, and when the tunnel connection is exclusively used by the network element ...”

In fact, the text related to the cited figure concerns multi-casts and does not define a tunnel in a way that precludes a plurality of network elements from jointly using the same tunnel connection during a multi-cast transmission. If this not were true, it would imply that multi-casting could not be performed in a NAT (Network Address Translation) method, i.e., that applicants' claimed invention would be required for all multi-casts. Also, citation of various host workstations in figure 3.2 of the SGI reference does not mean that the illustrated LANs each have only one work station. Rather, these are simplified illustrations.

The rejection also raises new points of argument without providing requisite support. At page 11 of the office action it is argued that Legacy network systems (prior art) use the invention, as though the rejection might be made under Section 102. Yet there is no prior art of record to support the Examiner's position and it is not clear how the Examiner could use the unsupported argument. If the intent is to rely on Legacy network systems to show that prior systems have used both element a and element b, then the combination used to reject the claims must include a reference disclosing the claimed feature.

With regard to both independent claims 8 and 23, applicants again contend that the citation of the SGI reference is in error and request removal of the rejection. Again it would not be obvious to reconstruct the alternate configurations based on differing conditions as presented in the claims. Even if the rejection did cite two separate references each disclosing one of two different configurations, this does not render the claimed subject matter obvious.

Conclusion

Based on the cited art and the above-noted deficiencies in the rejections, it appears that the claims contain allowable subject matter. If the Examiner disagrees, it is necessary to carry the burden of making a prima facie case of obviousness. The art of record is not sufficient for such. Thus it is incumbent upon the Examiner to either allow the claims or to address all of the deficiencies in the rejection. As a minimum, the Examiner should issue an advisory action which provides a detailed response to the above points of argument to establish a basis for moving forward on appeal.

The Examiner is reminded that the Applicants are enduring unnecessary cost and time delays as a result of a final rejection which is not responsive to the deficiencies previously made of record by the Applicants.

Serial No. 10/533,083
Atty. Doc. No. 2002P03505WOUS

The Commissioner is hereby authorized to charge any appropriate fees due in connection with this paper, including the fees specified in 37 C.F.R. §§ 1.16 (c), 1.17(a)(1) and 1.20(d), or credit any overpayments to Deposit Account No. 19-2179.

Respectfully submitted,

Dated: March 05, 2009

By: Janet D. Hood
Janet D. Hood
Registration No. 61,142
(407) 736-4234

Siemens Corporation
Intellectual Property Department
170 Wood Avenue South
Iselin, New Jersey 08830